PATENT
Attorney Docket No. 08731.0003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mark H. PAUSCH *et al.*

Application No.: 09/786,056) Group Art Unit: 1647

International Filing Date: September 1, 1999) Examiner: P. HOLBROOK

For: ENHANCED FUNCTIONAL EXPRESSION OF G PROTEIN-COUPLED RECEPTORS

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In a Restriction Requirement dated March 25, 2002, the period for response to which having been extended to May 25, 2002, by the attached Petition and fee, the Examiner required restriction under 35 U.S.C. §§ 121 and 272 between the claims of Group I (claims 1, 3, 4, and 6-13), the claims of Group II (claims 15-27), and the claims of Group III (claims 29-51). The Examiner has further restricted the claims into 26 additional Groups, based on Sequence Identifiers disclosed in the specification, but not specifically claimed. Applicants provisionally elect to prosecute Group I, claims 1, 3, 4, and 6-13, drawn to a yeast host cell comprising a constitutively active heterologous G protein-coupled receptor and its method of use to screen compound, *with* traverse. Currently, claims 1, 3, 4, 6-13, 15-27, and 29-51 are pending in this application.

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With regard to restriction of the claims based on Groups I-III, Applicants respectfully submit that claims 1, 3, 4, 6-13, and 29-51 relate to a single special technical feature that defines an inventive contribution over the prior art. Specifically, all of these claims are directed to modified G protein-coupled receptors that are constitutively active (*i.e.*, active even in the absence of their physiological ligand). Accordingly, Applicants submit that restricting these claims from one another was improper under PCT Rule 13.2. Thus, Applicants submit that these claims should be rejoined and examined in this application.

With regard to restriction of the claims based on SEQ ID NOs:1-26, Applicants respectfully submit that the requirement is not relevant to elected Group I. SEQ ID NOs:1-26 are oligonucleotide primers (SEQ ID NOs:1-16 and 18-26) and a short peptide (SEQ ID NO:17). None of these Sequence Identifiers are recited in the elected claims. Accordingly, Applicants respectfully submit that restriction based on SEQ ID NOs:1-26 was in error.

Because the Restriction Requirement states that "applicant is required . . . to elect a single invention to which the claims must be restricted, and because restriction based on SEQ ID NOs:1-26 is not relevant to Group I, Applicants believe that election of a single Sequence Identifier is not required under the Restriction Requirement. If the Office's intent was to have Applicants elect a single Sequence Identifier in addition to a Group, Applicants respectfully request that the Office set fort a new Restriction Requirement that specifically states how restriction based on SEQ ID NOs:1-26 is proper in the context of the present claims.

Furthermore, Applicants submit that, in setting forth the requirement based on disclosed, but not claimed, Sequence Identifiers, the Office has attempted to improperly limit the scope of the claims through the Restriction Requirement. For example, in issuing the Restriction

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Requirement, the Office has, without Applicants' permission or approval, limited the scope of the claims to specific species (*i.e.,* sequences) that are disclosed in the application, but not specifically recited in the claims. Applicants respectfully submit that they have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose. Issuing a Restriction Requirement by incorporating an unclaimed limitation in an effort to limit the claim to disclosed embodiments, with the idea that Applicants would have to carve up that claim and pursue the non-elected subject matter in a separate application, violates this right under § 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

In addition, the Restriction Requirement makes it impossible for Applicants to obtain the full scope of their invention, even if every Group were to be pursued in all **seventy-eight** applications that would be required as a result of the Restriction Requirement, if the intent of the Office was to require Applicants to elect both a Group and a single Sequence Identifier. For example, even if Applicants pursued each and every Group set forth in the Restriction Requirement, they still would not obtain full coverage for claim 1, which generically recites a yeast host cell comprising a constitutively active heterologous G protein-coupled receptor. Thus, the Restriction Requirement as it relates to Sequence Identifiers is improper because it completely eliminates subject matter from the application.

In view of the above remarks, Applicants request reconsideration and withdrawal of the Restriction Requirement, at least with respect to Groups I and III. In the event that the Office

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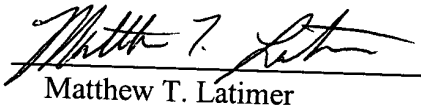
does not withdraw the Restriction Requirement, Applicants reserve the right to Petition the Commissioner to have the Restriction Requirement reviewed and/or to prosecute the non-elected claims in divisional or continuation applications.

Please grant any extensions of time required to enter this response and charge any required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

By: 

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